

REMARKS

By this amendment, claims 1 and 9 have been amended to overcome the objections under 35 U.S.C. §112.

Claims 1, 5 and 6 stand rejected under 35 U.S.C. §102(b) over Moore, U.S. Patent No. 5,121,307. Claim 1 has been modified to recite that the cover receives the stanchion substantially in its entirety, such that the bottom (open) end is proximate to, or in contact with, the ground surface. This clearly distinguishes over the Moore reference, which is adapted only to fit over the top end an electric power or telephone pole (col. 2, lines 18-19). Clearly the cover is Moore could not extend down to the ground surface due to the wires and other obstacles that telephone and utility poles are designed to support. Given that anticipation requires a single prior-art reference to disclose each and every element of a claimed element, it is believed that the rejection under §102 has been overcome.

Given that all of the dependent claims of this application depend from claim 1, it is believed that claims 2-11 are allowable as well. Regarding claims 7 and 8, however, the Examiner stated that it would have been obvious to paint a message with stenciled letters on the tubular cover of Moore. Applicant respectfully disagrees, however, since the device of Moore is used at a high altitude, particularly for helicopters or other low-flying aircraft, such that a message would not be visible. Obviousness cannot be established where there is no reasonable degree of success.

Claims 9-11 stand rejected under 35 U.S.C. §103 over Moore in view of Padilla et al., U.S. Patent No. 5,121,307. The Examiner concedes that Moore does not disclose light-dispersing windows, a message displayed by a plurality of light sources, or light sources in the form of light-emitting diodes.

The Examiner states that it would have been obvious to modify the lighting assembly of Moore with the tubular body taught by Padilla "for benefits and advantages of eye-catching displays and for traffic

safety in dark.” However, Applicant disagrees for several reasons. First, as discussed above, given that the cover of Moore is intended for tops of utility poles, and the like, at distances high above the ground, the desirability of a “eye-catching display” makes little practical sense. In addition, it is well settled that, in order to establish *prima facie* obviousness in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant’s claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

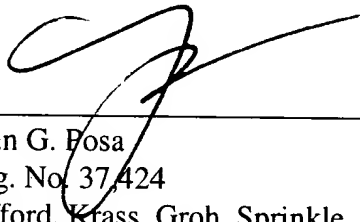
Additionally, it is Applicant’s contention that Padilla represents non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem”); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In this case, Padilla, being directed to a bicycle lighting device bears no relation whatsoever to the problem facing Applicant.

Based upon the foregoing, Applicant believes all claims are in condition for allowance. Questions regarding this application can be directed to the undersigned attorney at the telephone/facsimile numbers provided.

Attached is a version showing the changes made to claims 1 and 9.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

1. (Amended) A [lighted stanchion cover] lighting assembly for use with a stanchion extending outwardly from a [fixed] ground surface comprising:

an elongated tubular body having an open end [,] and a closed end defining an interior cavity, the open end and the interior cavity of the elongated tubular body being dimensioned to receive the stanchion substantially entirely therein such that the open end is proximate to or in contact with the ground surface; and

a lighting assembly, having a light source interconnected to a power source, the light assembly being secured relative to the tubular body so that the light is visible exteriorly of the interior cavity.

9. (Amended)The elongated tubular body defined in claim 1 wherein the body includes [is] one or more light dispersing windows.